Mark R. Williams
682 S. 7th St.
San Jose CA 95112
re Application No. 09/652,387
Att. Dkt. No. 253/232

Attorney Alesia M. Brown
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Attorney Brown:

I am writing you to request reconsideration of my petition to revive my application, and ask you to please help me understand what is lacking in my resubmission.

Along with my patent attorney, I made efforts in 2003 to 2004 trying to clarify objections by the examiner to my application. After my attorney's firm went out of business, I took on the efforts by myself, and in June of 2004 I finally realized why the examiner had misunderstood my intent.

I had used the term "commercial messages", which the examiner had interpreted as data messages related to commerce, such as in a financial institution computer system. Instead, I had intended "advertising messages" such as TV or radio ad spots.

Starting from that point:

- I submitted a Reply clarifying the usage of terminology in my original application; which was received by the Patent Office 06-21-2004. Copy is attached.
- The Office sent a reply on 07-23-2004, advising me that my amendments to " 'advertising message' have changed the scope of the claims that would require further consideration and search." Copy is attached.

Office on 09-14-2004. In it, I checked the Previously Submitted box, referring to the amendments in Reply attachment.

I am not able to understand why the Reply referenced in the RCE did not count as a submission. Nonetheless, I am re-submitting the RCE form, and referencing the enclosed Reply as the submission.

I would appreciate it if you could call me once you have received and read this submission. My cell phone number is (408) 206-6910. If for some reason I do not answer, please leave me a message with a time when you will try again, and I assure you I will be waiting for your call.

Sincerely,

Mark R. Williams

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Mark R. Williams	Art Unit	: 2177
Serial No.	: 09/652,387	Examiner	: Debbie M. Le
Filed	: August 31, 2000		
Title	: METHODS AND APPARATUSES FOR MEDIA FILE DELIVERY		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY

Dear Patent Examiner:

I am writing you as inventor and filer of the above named patent application. I filed this application as a private individual. As I have now exhausted all my funds for patent attorneys to

- The invention does nothing to prevent the music download, or to assure a "secure" transfer. However, during the music file transfer it additionally downloads to the player unit a file containing advertising messages, and uploads from the player unit a record of previous listening activity.

- After this download/upload activity, the player unit is disconnected from the network and has no further requirement for connection until the user wishes to download new audio files.

- When the user plays the music from the player unit, the invention does three things:

    1. It checks the identifier that was appended to the music file to determine whether it matches that of the player unit. If not, the music file may have come from another source. For example, the music file could have been downloaded from someone else's PC.

    2. If the music file didn't come from the player unit owner's PC, the player unit plays one of the brief (~3 sec long) advertising messages from the previously downloaded file just prior to playing the song.

    3. If the commercial message is played, the player unit takes note of the advertising message number, associates this with the industry-standard identifier that came with the downloaded music selection itself, and stores both in memory as a record of listening activity.

- Note that the player unit **cannot** prevent the audio file from playing back, regardless of whether an advertising message was played along with it.

- The next time the player unit is attached to the PC for music downloads, the above-mentioned record of previous listening activity is uploaded.

- Once uploaded to the PC, the listening activity information is sooner or later transferred back via network connection to a service that charges the advertiser for the commercial

played, and pays the recording artist or company for the music heard. The user is unaware of and uninvolved in this activity. Moreover, the transfer of this information back to the service happens independently of the music download (probably in the background at a later time).

Unlike what is claimed in other patents, the user is **never** prevented from listening to music (even a pirated copy) and never signs up for any type of billing service or is in any way responsible for paying money for listening to the music.

II. Regarding the Berry patent as a basis for rejecting my claims:

One of the points of misunderstandings I mentioned earlier has to do with "commercial messages." I am not talking about "commercial" as in "related to commerce" – I'm talking about advertisements – like ads on the radio. I believe that when re-read in this context, my claims are quite dissimilar to those of Berry.

In addition, Berry teaches about manipulating "identifiers". But as made quite clear even in the Berry abstract, the patent offers:

"A method and system in a multimedia computer system for automatically retrieving and presenting data associated with an audio recording..."

The "identifiers" of my invention are **not** associated with the audio recording content. They serve only to indicate the ownership of the file, and have nothing to do with the file contents.

III. Regarding the Simmons patent as a basis for rejecting my claims:

This is the other point of misunderstanding. My invention never attempts to prevent audio playback, nor does it provide a means of charging the user a fee for the content.

- Simmons sections [0022] and [0040] talk about using an identifier for the purposes of "the requested file being uniquely dynamically encrypted such that it can only be played back on the requesting player/receiver...". The purpose of the identifier on my invention

is to determine whether an advertising message should be played, **not** to prevent playback of the content. This was not foreseen by Simmons.

- Simmons sections [0045] and [0049] focus on "encryption" of the media file to prevent the content from being played unless all conditions are met. My invention does **not** encrypt content files, since it does not want to prevent them from being played. The word "encryption" does not appear anywhere in my claims, because there is never any attempt made to secure the music.

- Simmons section [0050] focuses on the electronic transaction control mechanism designed to ensure that users pay for content. It uses an electronic serial number as part of this process. My invention does **not** require the user to pay for content. It uses the electronic serial number of the player unit for an entirely different purpose – to determine whether both the audio file and the player unit belong to the same user (the advertising messages are played if the numbers don't match).

For Simmons to have foreseen my invention, it would have to allow download and unrestricted playback, of any content from any source, at no cost to the user. This is exactly the opposite of what Simmons intends.

In summary:

- Berry teaches how to retrieve additional information related to the audio file content.

- Simmons teaches how to determine whether the file content is allowed to be played back so as to ensure that the consumer pays for content.

- My patent teaches a way to let a content producer and an advertiser know that that advertiser's message has been played in conjunction with that producer's content, allowing the advertiser to compensate the content producer as appropriate.

My invention is using basic computer and networking concepts for an entirely different purpose than either Simmons or Berry.

Summary of Changes to Claims

- Claim 1: Since the word "identifier" alone is getting confused with the definition used in the Berry patent, I have clearly defined this identifier as NOT the one Berry refers to (the industry-standard Redbook audio CD identifier).

- Claims 2 and 4: The changes to claim 1 should make claims 2 and 4 clear without additional changes.

- Claims 5, 6, and 7: The only Berry references to "messages" are to network messaging packets. Moreover, the Berry patent doesn't teach anything about commercial advertisements. I have added the word "advertising" to claims 5 and 6 to make it clear that all "messages" referenced are advertising messages. I've canceled claim 7 because it is now redundant.
- Claims 9 and 10: The real purpose of the invention is to handle audio files. For simplicity I'm canceling the claims for video and text files.
- Claims 11, 13, 14, 15: I've amended or canceled these for the reasons given above for claims 5, 6, and 7.
- Claims 17 and 18: Canceled for the same reasons as given above for claims 9 and 10.

I ask that all claims be allowed in view of the amendments to the claims contained on the following sheets, a total of 5 pages.
Respectfully submitted,

Date:_____

_____
Mark R. Williams
Applicant

682 S. 7th Street
San Jose, CA 95112
(408) 971-0958

In the claims:

Please amend the claims as follows:

1. (currently amended) A method for uniquely marking a media file, comprising:

receiving a media file; and

appending ~~an~~ a player unit identifier onto the media file that is unrelated to the media file content.

2. (unchanged)

3. (previously canceled)

4. (unchanged)

5. (currently amended) The method of claim 1, further comprising receiving an advertising message file.

6. (currently amended) The method of claim 5, wherein the media file and the advertising message file arrive in a concatenated state.

7. (canceled)

8. (unchanged)

9. (canceled)

10. (canceled)

11. (currently amended) A method for delivering an advertising message file, comprising:

receiving a media file with a first identifier, wherein the first identifier uniquely identifies a player unit;

retrieving a second identifier, wherein the second identifier also uniquely identifies a player unit;

comparing the first identifier with the second identifier to determine whether the player unit identified by the first identifier is the same as the player unit identified by the second identifier;

retrieving an advertising message file and producing an advertising message output from the advertising message file if the first identifier does not correspond to the second identifier; and

producing a media output from the media file.

12. (unchanged)

13. (currently amended) The method of claim 11, wherein the step of retrieving an advertising message file comprises retrieving an advertising message file from a storage device.

14. (currently amended) The method of claim 11, wherein the step of retrieving an advertising message file comprises retrieving an advertising message file from a non-volatile memory.

15. (canceled)

16. (unchanged)

17. (canceled)

18. (canceled)

19. (unchanged)

20. (unchanged)

21. (currently amended) The method of claim 11, wherein the media file and the advertising message file are in a concatenated state.

22. (currently amended) The method of claim 11, wherein if the advertising message file cannot be retrieved, then the step of producing a media output is not carried out.

23. (currently amended) A player unit for delivering media files, comprising:

a processor;

a non-volatile memory communicatively coupled to the processor;

a first identifier stored in the non-volatile memory, wherein the first identifier uniquely identifies the player unit;

a communications port communicatively coupled to the processor and capable of communicatively coupling the player unit to a computer system;

a data storage drive communicatively coupled to the processor and capable of transferring data between the player unit and a removable data storage medium;

a first application program residing in the player unit and accessible by the processor, the application program comprising one or more sequences of instructions for uniquely marking a media file, the one or more sequences of instructions causing the processor to perform a number of acts, said acts comprising:

receiving a media file,

retrieving the first identifier from the non-volatile memory,

appending the first identifier onto the media file, and

storing the appended media file in the removable data storage medium; and

a second application program residing in the player unit and accessible by the processor, the application program comprising one or more sequences of instructions for delivering an advertising message file, the one or more sequences of instructions causing the processor to perform a number of acts, said acts comprising:

receiving a media file with a second identifier, wherein the second

identifier uniquely identifies a player unit,

comparing the second identifier to the first identifier to determine whether the player unit identified by the second identifier is the same as the player unit identified by the first identifier,

retrieving an advertising message file from the non-volatile memory and producing an advertising message output from the advertising message file if the second identifier does not correspond to the first identifier, and producing a media output from the media file.

24. (currently amended) A player unit for delivering files, comprising:

a first logic circuit configured to perform a number of acts, said acts comprising:

receiving a media file,

retrieving a first identifier that uniquely identifies the player unit,

appending a representation of the first identifier onto the media file, and

storing the appended media file in a removable data storage medium;

a second logic circuit configured to perform a number of acts, said acts comprising:

receiving a media file with a second identifier, wherein the second identifier uniquely identifies a player unit

comparing the second identifier to the first identifier to determine whether the player unit identified by the second identifier is the same as the player unit identified by the first identifier,

retrieving an advertising message file from the non-volatile memory and producing an advertising message output from the advertising message file if the second identifier does not correspond to the first identifier, and

producing a media output from the media file;

a non-volatile memory communicatively coupled to the logic circuits for storing the first identifier;

a communications port communicatively coupled to the logic circuits and capable of communicatively coupling the player unit to a computer system; and

a data storage drive communicatively coupled to the logic circuits and capable of transferring data between the player unit and a removable data storage medium.

25. (unchanged)

26. (unchanged)

27. (unchanged)

Advisory Action	Application No.	Applicant(s)	
	09/652,387	WILLIAMS, MARK R.	
	Examiner	Art Unit	
	DEBBIE M LE	2177	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 21 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 2/9/04. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to: *none*.

   Claim(s) rejected: *1-2, 4-18, 21-2.7*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

7/20/04

GRETA ROBINSON
PRIMARY EXAMINER